REMARKS / DISCUSSION OF ISSUES

Claims 1-26 are pending in the application.

Claims are amended for non-statutory reasons: to correct one or more informalities, remove figure label numbers, and/or to replace European-style claim phraseology with American-style claim language. The claims are not narrowed in scope and no new matter is added.

The Office action rejects claims 9-17 under 35 U.S.C. 101. The applicants respectfully traverse this rejection.

The Office action asserts that the claimed invention is directed to non-statutory subject matter because the claimed process "may be performed by hand with a pencil and paper". The Office action fails to identify a statutory basis for the assertion that methods that may be performed manually, using pencil and paper, are barred from patentability.

The applicants respectfully maintain that the ability to perform a method with pen and paper does not, per se, preclude patentability under 35 U.S.C. 101:

> **35 U.S.C. 101 Inventions patentable.**
> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The applicants respectfully maintain that the applicants claim a new and useful process in claims 9-17, and there are no conditions or requirements in 35 U.S.C. that prohibit patents for processes that may also be performed manually. The applicants note that the original patent laws written by Thomas Jefferson were written long before computers and automation, and most method claims address manual processes. The applicants further note that most computer processes can be performed manually, albeit less efficiently.

MPEP 2106 specifically provides guidance for evaluating computer-related inventions:

> "Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. ***Only when the claim is devoid of***

> ***any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.*** ...
> As the Supreme Court has held, Congress chose the expansive language of 35 U.S.C. 101 so as to include "***anything under the sun that is made by man.***" *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980)...
> This perspective has been embraced by the Federal Circuit:
> The plain and unambiguous meaning of section 101 is that ***any new and useful process***, machine, manufacture, or composition of matter, or any new and useful improvement thereof, ***may be patented*** if it meets the requirements for patentability set forth in Title 35, such as those found in sections 102, 103, and 112. ***The use of the expansive term "any" in section 101 represents Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in section 101 and the other parts of Title 35.*** . . .
> Thus, **it is improper to read into section 101 limitations as to the subject matter that may be patented where the legislative history does not indicate that Congress clearly intended such limitations.** *Alappat*, 33 F.3d at 1542, 31 USPQ2d at 1556.

The applicants respectfully note that Congress did not say "any thing under the sun that is made by man *that cannot also be done with pencil and paper*", as the Office action implies. The applicant also notes that MPEP 2106 states "Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected".

The practical application of the claimed invention to the technical arts is presented throughout the specification, and as such, the applicants respectfully maintain that claims 9-17 are patentable under 35 U.S.C. 101, per MPEP 2106.

The Office action rejects:

claims 1-6, 9-14, and 17-26 under 35 U.S.C. 102(e) over Hosken (USP 6,438,579); and

claims 7-8 and 15-16 under 35 U.S.C. 103(a) over Hosken and Bergh (USP 6,112,186).

The applicants respectfully traverse this rejection.

Independent claim 1, upon which claims 2-8 depend, claims an automated recommendation system that includes a processor that generates at least two sets of predictions based on one or a combination of sets of a user's profile data, and

combines the predictions by weight-averaging corresponding ones from each of the at least two sets of predictions.

Independent claim 9, upon which claims 10-18 depend, claims a method that includes generating at least two sets of predictions based on one or a combination of sets of profile data based on a user's preferences; and combining the predictions by weight-averaging the at least two sets of predictions.

Independent claim 18, upon which claims 19-20 depend, claims an automated recommendation system that includes a processor that generates at least two sets of predictions based on one or a combination of the sets of profile data based on a user's preferences and combines the predictions by weight-averaging the at least two sets of predictions.

Independent claim 21, upon which claims 22-23 depend, claims a method that includes generating at least two sets of predictions based on one or a combination of sets of profile data based on a user's preferences and combining the predictions by weight-averaging the at least two sets of predictions.

Independent claim 24, upon which claims 25-26 depend, claims a method that includes generating first and second profile data based on user preferences and applying the first and second profile data to respective prediction engines to produce first and second results and combining these results.

The Examiner's attention is requested to MPEP 2131, wherein it is stated:

> "A claim is anticipated only if ***each and every element*** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The ***identical invention*** must be shown in as ***complete detail*** as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

And, to MPEP 2142, wherein it is stated:

> "To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) ***must teach or suggest all the claim limitations.***" ... If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

Hosken does not teach creating two sets of predictions from profiles based on a user's preferences and combining these sets of predictions. The Office action asserts that Hosken's two profiles that are based on the implicit and explicit data associated with the user corresponds to the applicants' claimed two sets of profiles; the applicants do not disagree with this characterization of Hosken. The applicants respectfully maintain, however, that Hosken does not teach determining two sets of predictions from these two profiles, as specifically claimed by the applicants in each of the applicants' independent claims. Hosken specifically teaches determining a single set of predictions (Recommended Set 72, in FIG 2) based on the user's implicit and explicit behaviors.

The Office action asserts that Hosken teaches combining two sets of predictions at column 16, lines 23-38; the applicants do not disagree with this characterization of Hosken. However, the applicants respectfully note that the two sets of predictions that are combined are not the two sets of predictions based on the user's profiles, as specifically claimed by the applicants in each of the applicants' independent claims. As taught by Hosken, the two sets of predictions include the 'content-related' predictions based on the user's preferences, and the 'collaborative filtering generated' predictions based on other user's preferences.

Because Hosken does not teach or suggest generating two sets of predictions based on profiles developed from a user's preferences, and does not teach combining these two sets, as specifically claimed in each of the applicants' independent claims, the applicants respectfully maintain that the rejection of claims 1-26 under 35 U.S.C. 102(e) or 103(a) over Hosken is unfounded, per MPEP 2131 and 2142.

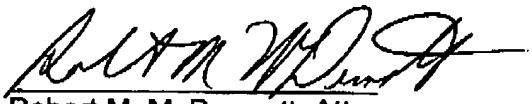
The Office action rejects claim 24 under 35 U.S.C. 102(e) over Martino et al. (USP 6,662,177, hereinafter Martino). The applicants respectfully traverse this rejection.

As noted above, independent claim 24, upon which claims 25-26 depend, claims a method that includes generating first and second profile data based on user preferences and applying the first and second profile data to respective prediction engines to produce first and second prediction results and combining these results.

Martino does not teach applying first and second profile data to prediction engines to provide first and second prediction results, and does not teach combining these results. As such, the applicants respectfully maintain that the rejection of claim 24 under 35 U.S.C. 102(e) is unfounded, per MPEP 2131.

In view of the foregoing, the applicants respectfully request that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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